



Fox Rothschild LLP
ATTORNEYS AT LAW

2000 Market Street, 20th Floor
Philadelphia, PA 19103-3222
Tel 215.299.2000 Fax 215.299.2150
www.foxrothschild.com

Joseph Posillico
Tel: 215-299-2902
E-Mail jposillico@foxrothschild.com

November 20, 2009

Via Facsimile

Board of Patent Appeals and Interferences
Clerk of the Board
P.O. Box 1450
Alexandria, VA 22313-1450

RE: Appeal No. 2009-007470
US Patent Application No. 10/679,871
Epoxy-based Anchoring Composition

Dear Sirs:

On November 19, 2009, I participated in an oral hearing for the above-mentioned case. During the oral hearing, the Board raised a question of fact about a vinyl ester composition described in the original specification of this application under the trade name "Norpol Dion Ver 9165". (See Specification, p. 14, lines 8 – 9.) More particularly, the Board questioned whether the existence of this composition would be indicative of a suggestion to use the vinyl toluene in an epoxy resin composition. I indicated that such a suggestion would not be present if the composition was not prior art to the claimed invention. Unfortunately, when this question was posed, I did not immediately recall all of the relevant facts regarding this composition.

To provide a more complete answer to the Board's inquiry and to clarify this matter, this composition was discussed on Friday of last week via telephone with Barbara Chabut, one of the named inventors. Mrs. Chabut confirmed that a formulation of bisphenol-A epoxy resin in a vinyl toluene diluent was an embodiment of the invention (which is assigned to Illinois Tool Works (ITW)) and that subsequent to the conception of the invention, ITW asked Reichhold Inc., a leading manufacture of resin materials, to prepare, on a confidential and a proprietary basis, a formulation of a bisphenol-A epoxy resin in a vinyl toluene diluent exclusively for ITW. This formulation, which was identified in appellant's application as Norpol Dion Ver 9165 in a vinyl toluene diluent,

PHI 2425864v1 11/23/09

A P O S I L L I C O, L L P, Limited Liability Partnership

California

Connecticut

Delaware

Florida

Nevada

New Jersey

New York

Pennsylvania



Fox Rothschild LLP
ATTORNEYS AT LAW

Appeal No. 2009-007470
US Patent Application No. 10/679,871
Epoxy-Based Anchoring composition

was not otherwise available prior to the filing date of the application. Accordingly, appellant's own disclosure of this composition in their patent application should not be read as suggesting that this material was for sale or otherwise publicly available prior to the filing date of this application.

Kindly consider my follow-up answer to your question when determining the patentability of the claimed invention. If you have any subsequent questions regarding this matter, please do not hesitate to contact me.

Sincerely,

Joseph Posillico

JFP:kph

FACSIMILE COVER SHEET**FOXROTHSCHILD LLP**

2000 Market Street
Philadelphia, PA 19103
(215) 299-2000
Facsimile Machine (215) 2150

PLEASE DELIVER THE FACSIMILE TRANSMITTED HEREWITH TO:

Name: Clerk of the Board
Board of Patent Appeals and Interferences

From: Joseph F. Posillico

Re: Appeal No. 2009-007470
Application No. 10/679,871
Epoxy-based Anchoring Composition

A total of 3 pages, including this cover sheet, will be transmitted.

Confirmation copy sent: ☐ Yes ☒ No

Name of Operator: Kathy P. Higgins

Date Sent: November 23, 2009

Facsimile number of 1-571-273-0299

Billing No. 54600-00056

=====

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE ADDRESSEE AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED AND CONFIDENTIAL. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR PLEASE NOTIFY US BY TELEPHONE IMMEDIATELY. TO DO SO, YOU MAY CALL US COLLECT.



Fox Rothschild LLP

ATTORNEYS AT LAW

2000 Market Street, 10th Floor

Philadelphia, PA 19103-3291

Voice: (215) 299-2000 Fax: (215) 299-2150

Date: Monday, November 23, 2009 3:43:02 PM

Facsimile Transmittal Sheet

To:
Board of Patent Appeals

Company:

Fax number:
1-571-273-0299

Phone number:

From:
Joseph F. Posillico

Phone number:
215-299-2902

Number of pages:
04

Client/Matter number:
54600 00056

If you do not receive all of the pages,
please call (215) 299-2000 as soon as possible.

Notes/Comments:

IRS CIRCULAR 230 DISCLOSURE:

PURSUANT TO TREASURY REGULATIONS, ANY TAX ADVICE CONTAINED IN THIS COMMUNICATION (INCLUDING ANY ATTACHMENTS) IS NOT INTENDED OR WRITTEN TO BE USED, AND CANNOT BE USED OR RELIED UPON BY YOU OR ANY OTHER PERSON, FOR THE PURPOSE OF (i) AVOIDING PENALTIES UNDER THE INTERNAL REVENUE CODE, OR (ii) PROMOTING, MARKETING OR RECOMMENDING TO ANOTHER PARTY ANY TAX ADVICE ADDRESSED HEREIN.

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA THE U.S. POSTAL SERVICE. THANK YOU.